

109. (New) The composition according to claim 1, wherein said at least one cationic direct dye is present in said composition in an amount sufficient for lightening direct dyeing.

REMARKS

I. Disposition of the Claims

Claims 1 to 68, 70 to 74, 76, 77, 79 to 106, 108, and 109 are pending and are subject to a restriction requirement. Claims 1 to 5, 7, 8, 14 to 31, 62 to 83, and 107 stand rejected. Please withdraw, without prejudice, claims 6, 9 to 13, 32 to 61, and 84 to 106 from consideration pending Applicants' traversal of the restriction requirement found in section II of these Remarks. Claims 108 and 109 are new and should be examined with the elected Group and species.

Support for new claim 108 is found in the specification as filed (e.g., p. 63, line 14-p. 64, line 2 and p. 65, lines 14-17). Support for new claim 109 is found in the specification as filed (e.g., p. 65, lines 17-18). No new matter has been added, and these amendments were not made in view of any prior art document.

II. Response to the Restriction and Election Requirements

The Office applied a three way restriction requirement for the reasons set forth beginning at page 2 of the outstanding Office Action. Although Applicants affirm their election of Group I, Applicants respectfully traverse this requirement.

The Office required restriction under 35 U.S.C. § 121 to one of the following groups of claims:

Group I: claims 1 to 83, 106, and 107 directed to a ready-to-use composition for dyeing fibers;

Group II: claims 84 to 97 directed to a process for dyeing fibers; and

Group III: claims 98 to 105 directed to a multi-compartment dyeing kit.

The Office also requires an election of species from within the elected Group.

The restriction and election of species requirements are respectfully traversed.

However, to be fully responsive to these requirements, Applicants affirmatively elected, with traverse, claims reciting a composition comprising:

- (i) at least one cationic direct dye chosen from compounds of formula (I); and
- (ii) at least one thickening polymer chosen from nonionic amphiphilic

polymers.

The Office considers claims 1 to 5, 7, 8, 14 to 31, 62 to 83, and 107 as generic.

Claims 108 and 109 are new and should be examined with the elected Group and species. In the event that the Office makes the restriction requirement final, the Office should at least examine claims 1 to 5, 7, 8, 14 to 31, 62 to 68, 70 to 74, 76, 77, 79 to 83, 108, and 109 as generic claims.

Applicants initially traverse the restriction requirement on the grounds that the Office has not shown that there would be a serious burden to examine the claims of Groups I to III together. Applicants respectfully submit that a search of the subject matter of Groups I to III would not be burdensome, because a search of class 8, subclass 405+ (*i.e.*, the single class indicated for each Group at p. 2 of the Office Action) would seem to encompass the search of the subject matter of each Group.

For at least this reason, Applicants respectfully submit that no serious burden exists to examine the claims of Groups I to III together and request that these claims be regrouped together. Thus, Applicants respectfully submit that the restriction

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requirement is in error and request that the restriction and election requirements be withdrawn.

In addition, Applicants traverse the election requirement, because the Office has improperly carved up the claimed invention. As evidenced by the requirement set forth in the Office Action, the Office has required election within the independent claims defining Applicants' invention. This is improper. Applicants have a statutory right under 35 U.S.C. § 112, second paragraph, to claim the subject matter they regard as their invention in the manner they choose. Issuing an election requirement within a claim with the idea that Applicants would have to carve up that claim and pursue the nonelected subject matter in a separate application violates this right under Section 112. Indeed, the C.C.P.A. has characterized such action as tantamount to a refusal to examine. *In re Weber*, 198 U.S.P.Q. 328 (C.C.P.A. 1978); *In re Haas*, 198 U.S.P.Q. 334 (C.C.P.A. 1978).

35 U.S.C. § 121 gives the Office authority to promulgate rules designed to restrict an application to one of several claimed inventions when those inventions are found to be independent and distinct. 35 U.S.C. § 121, however, does not give the Office authority to reject an individual claim on that basis. *Weber* 198 U.S.P.Q. at 332.

In *Weber*, the Examiner and the Board rejected Weber's claims for containing improper Markush groups and also under 35 U.S.C. § 121. *Id.* at 329. The Examiner took the position that claim 1 embraced 24 enumerated independent and distinct inventions. *Id.* at 330. Giving the PTO position short shrift, the predecessor court to the Federal Circuit reversed, reasoning that:

As a general proposition, an applicant has the right to have

each claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim.

Id. at 331.

In *Haas*, decided the same day as *Weber*, the same court expressly held that 35 U.S.C. § 121 does not furnish a basis for rejecting a claim for containing improper Markush groups and misjoinder of invention even if the claim is viewed as encompassing independent and distinct inventions. Clearly, therefore, the Office has no authority via restriction practice (35 U.S.C. § 121) to require Applicants to excise the nonelected subject matter from the pending claims.

Accordingly, Applicants respectfully request that the full scope of the claimed invention continue to be examined in this application without restriction or election requirement. If the Office chooses to maintain the election requirement, Applicants expect the Office, if the elected species is found allowable, to continue to examine the full scope of the elected subject matter to the extent necessary to determine the patentability thereof, that is, extending the search to a reasonable number of the non-elected species, as is its duty according to *M.P.E.P.* § 803.02 and 35 U.S.C. § 121.

In view of the foregoing remarks, Applicants respectfully submit that both the restriction and the election of species requirement are in error and request that the

requirements be withdrawn. In any event, only claims 6, 9 to 13, 32 to 61, and 84 to 106 should have been withdrawn from consideration.

IV. Objection to the Specification

The Office objects to the specification for the reasons found beginning on page 5 of the outstanding Office Action. The Office argues that claim 107 lacks antecedent basis in the specification. Applicants have cancelled claim 107, and have not replaced it, thereby rendering this objection moot. Thus, Applicants respectfully request that this objection be withdrawn.

V. Rejections under 35 U.S.C. § 112, Second Paragraph

The Office objects to claims 69, 75, 78, and 107 as being indefinite for the three reasons found on page 6 of the outstanding Office Action. First, the Office rejects claims 69, 75, and 78, because the term "is present in an amount sufficient for" is "unclear in what the composition is present" (Office Action at p. 6, ¶ 2). Applicants have cancelled each rejected claim thereby rendering this rejection moot with respect to each claim. Additionally, Applicants respectfully submit that neither of new claims 108 and 109 raises this issue. Instead, the new claims make clear what is present in the claimed composition "in an amount sufficient for" Thus, Applicants respectfully request that this rejection be withdrawn.

Second, the Office rejects claims 69 and 75 as being duplicates (Office Action at p. 6, ¶ 3). Applicants have cancelled claim 75, thereby rendering this rejection moot. Applicants respectfully request that this rejection be withdrawn.

Third, the Office rejects claim 107 for reciting the composition in the form of a sunscreen and asks for clarification. Applicants have cancelled claim 107, thereby

rendering this rejection moot. Thus, Applicants respectfully request that this rejection be withdrawn.

VI. Rejections Under 35 U.S.C. § 103(a)

Over Jones in view of Rondeau

The Office rejects claims 1 to 5, 7, 8, 14 to 19, 24, 31, 62 to 83, and 107 as being obvious over the teachings of *Jones* (U.S. Pat. No. 6,106,578) in view of those of *Rondeau* (U.S. Pat. No. 5,879,412) for the reasons found on pages 7 to 9 of the outstanding Office Action. Under Section 103(a) and according to *M.P.E.P.* § 2143, the Office has the initial burden to establish a *prima facie* case of obviousness by pointing to three basic criteria, all of which are relevant here. One of these criteria dictates that the prior art relied on by the Office, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify the teachings of a reference and/or to combine the teachings of references. *M.P.E.P.* § 2143.01. At least because the teachings of *Jones* cannot be properly modified or combined with those of *Rondeau* for lack of the required motivation, Applicants respectfully submit that the Office has failed to meet its burden of establishing a *prima facie* case of obviousness.

Jones describes a composition comprising:

a) one or more hair dyeing agents; b) at least 0.1 weight percent of at least one hydrophobically modified nonionic polymer, based on the total weight of the hair dye composition, c) at least 0.1 weight percent of at least one associative agent, based on the total weight of the hair dye composition; and d) water.

(col. 2, lines 61-67). *Jones* states: "[t]he dyeing agents include for example permanent, semi-permanent, or temporary dyes, or combinations thereof" (col. 9, lines 43-45) such

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as azo and basic dyes (col. 10, lines 22-35). It teaches the hydrophobically modified nonionic ("HPN") polymer contains "at least one hydrophobic group" (col. 4, line 28) and includes:

polyethoxylated urethane, or hydrophobically modified naturally derived polyols such as a hydrophobically modified cellulose, or hydrophobically modified starch, or combinations thereof. The most preferred HNP is a polyethoxylated urethane.

(col. 4, lines 39-43). *Jones*, as the Office admits, does not teach the presently recited cationic direct dyes as recited, e.g., in claim 1 (Office Action at p. 8).

To remedy this deficiency, the Office combines the teachings of *Jones* with those of *Rondeau*. *Rondeau* describes a composition comprising:

at least one oxidation base selected from para-phenylenediamines and bis(phenyl)alkylenediamines, and the acid-addition salts thereof,
at least one coupler selected from meta-phenylenediamines, and the acid-addition salts thereof,
at least one cationic direct dye of formula I below, and
at least one oxidizing agent.

(col. 2, lines 1-8). As the Examiner points out, *Rondeau*'s cationic direct dyes of formula I do overlap with the presently recited "at least one cationic direct dyes" of, e.g., present claim 1. *Rondeau* also teaches that its

"compositions . . . can also contain various adjuvants used conventionally in compositions for dyeing the hair, such as . . . anionic, cationic, nonionic or amphoteric polymers or mixtures thereof, [and] inorganic or organic thickeners"

(col. 10, lines 39-47).

In view of these teachings, the Office contends that one of ordinary skill in the art would have been motivated to "add a direct dye as claimed to the compositions of *Jones*, which contain oxidation bases, couplers, oxidants and nonionic amphiphilic

polymers as claimed" (Office Action at p. 9). As motivation, the Office argues that "Jones teaches that direct dyes, including azo dyes and basic dyes, may be used in admixture with the patentee's oxidation dyes, and Rondeau teaches that the claimed cationic direct dyes result in improved endurance and glints when added to oxidative hair dyeing compositions" (Office Action at p. 9). Additionally, as motivation the Office argues that "Jones's compositions may contain the same mixtures of oxidation bases and couplers taught by Rondeau, and Rondeau teaches that the direct dyes are compatible with the nonionic polymers and surfactants (Jones's required additives)" (Office Action at p. 9). Applicants respectfully submit that these statements do not provide the required motivation to support a *prima facie* case of obviousness.

To prevent the use of hindsight based on the invention to defeat patentability of an invention, the Office must show a motivation to combine the references that create the case of obviousness. In other words, the Office must show reasons that the skilled artisan, confronted with the same problems as the inventor and lacking knowledge of the claimed invention, would choose the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 USPQ2d 1453, 1457-8 (Fed. Cir. 1998). Importantly, with respect to this motivation, the Federal Circuit placed the burden on the Office to present "clear and particular" evidence showing motivation to combine. *In re Dembiczak*, 50 USPQ.2d 1614 (Fed. Cir. 1999).

This is important because *Jones* and *Rondeau* do not suggest adding the **particular** dyes of *Rondeau*, let alone the **particular** dyes recited, e.g., in present claim 1, to the compositions of *Jones*. *Jones* does state its dyeing agents can include azo and basic dyes. The cationic direct dyes of *Rondeau*, and the present invention, fall

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within the vast scope of "azo" dyes. However, the potentially infinite member group containing all azo and basic dyes does not suggest the particular dyes of *Rondeau*, which are **particularly** chosen from its cationic direct dyes of formula I, or those dyes of the present invention. According to *M.P.E.P.* § 2143.01, just because references can be combined or modified does not render the resultant combination obvious: the prior art must also suggest the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

As its desirable reason, the Office states "*Rondeau* teaches that the claimed cationic direct dyes result in improved endurance and glints when added to oxidative hair dyeing compositions." Applicants disagree with this interpretation. More specifically, Applicants believe the Office bases this motivation on the following passage in *Rondeau*:

The present invention is aimed at proposing novel **compositions** for the oxidation dyeing of keratin fibers, and in particular human keratin fibers such as the hair, which make it possible to obtain radiant colorations that are rich in glints while at the same time with good endurance properties, in particular.

(col. 1, lines 59-64) (emphasis added). Thus, this passage of *Rondeau* does not teach that the cationic direct dye itself imparts "good endurance properties": it teaches that its composition comprising three other ingredients makes it possible to impart this property.

Based upon this passage of *Rondeau*, to have a chance of achieving *Rondeau's* desirous properties, one of ordinary skill in the art would have had to add *Rondeau's* entire hair dye composition to *Jones's* hair dye composition. This addition would be unnecessary to realize the Office's motivation. Simply, one would not need to add *Rondeau's* composition to that of *Jones* to achieve the desirous result, because

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Rondeau's compositions make it possible to achieve this result. Only hindsight by way of the present specification suggests this combination. Thus, the Office cannot meet its burden of establishing a *prima facie* case of obviousness for lack of the required motivation to combine and modify the teachings of *Jones* and *Rondeau*, and Applicants request that this rejection be withdrawn.

Over *de la Mettrie* in view of *Rondeau*

The Office rejects claims 1 to 5, 7, 8, 14 to 31, 62 to 83, and 107 as being obvious over the teachings of *de la Mettrie* (U.S. Pat. No. 6,010,542) in view of those of *Rondeau* for the reasons found on pages 9 to 11 of the outstanding Office Action. At least because the teachings of *de la Mettrie* cannot be properly modified or combined with those of *Rondeau* for lack of the required motivation, Applicants respectfully submit that the Office has failed to meet its burden of establishing a *prima facie* case of obviousness.

de la Mettrie describes

a composition for the oxidation dyeing of keratin fibers, and in particular of human keratin fibers such as the hair, comprising at least one oxidation dye precursor and optionally one or more couplers and at least one nonionic amphiphilic polymer containing at least one fatty chain and at least one hydrophilic unit.

(col. 1, lines 5-10). *de la Mettrie* states its compositions may comprise direct dyes like azo dyes (col. 7, lines 29-33). It, as the Office admits, does not teach the cationic direct dyes as recited, e.g., in present claim 1.

To remedy the deficiencies of *de la Mettrie*, the Office combines its teachings with those of *Rondeau*. Applicants have discussed the teachings of *Rondeau* above and will not repeat that discussion here.

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In view of these teachings, the Office stated that one of ordinary skill in the art would have been motivated to "add a direct dye as claimed . . . to the compositions of de la Mettrie, which contain oxidation bases, couplers, oxidants and nonionic amphiphilic polymers as claimed" (Office Action at p. 10). As motivation, the Office argues that "de la Mettrie teaches that direct dyes, including azo dyes, may be used in admixture with the patentee's oxidation dyes, and Rondeau teaches that the claimed cationic direct dyes result in improved endurance and glints when added to oxidative hair dyeing compositions" (Office Action at p. 11). Additionally, as motivation the Office argues that "de la Mettrie's compositions may contain the same mixtures of oxidation bases and couplers taught by Rondeau, and Rondeau teaches that the direct dyes are compatible with nonionic polymers (de la Mettrie's required additives)" (Office Action at p. 11). Applicants respectfully submit that these statements do not provide the required motivation to support a *prima facie* case of obviousness.

As noted above, the Office must present "clear and particular" evidence showing motivation to combine. *In re Dembiczak*, 50 USPQ.2d 1614 (Fed. Cir. 1999). Neither *de la Mettrie* nor *Rondeau* suggest adding the **particular** dyes of *Rondeau*, let alone the **particular** dyes recited, e.g., in present claim 1, to the compositions of *de la Mettrie*. *de la Mettrie* does state its compositions can include azo dyes. The cationic direct dyes of *Rondeau*, and the present invention, fall within the vast scope of "azo" dyes. However, the potentially infinite member group containing all azo does not suggest the particular dyes of *Rondeau*, which are **particularly** chosen from its cationic direct dyes of formula I, or those dyes of the present invention. Again, just because references can be combined or modified does not render the resultant combination obvious, because the

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prior art must also suggest the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

As its desirable reason, the Office states "Rondeau teaches that the claimed cationic direct dyes result in improved endurance and glints when added to oxidative hair dyeing compositions." Applicants disagree with this interpretation for the reasons noted above. More specifically, the passage quoted above from *Rondeau* does not teach that the cationic direct dye itself imparts "good endurance properties": it teaches that its composition comprising three other ingredients makes it possible to achieve this property.

Based upon this passage of *Rondeau*, to have a chance of achieving *Rondeau's* desirous properties, one of ordinary skill in the art would have had to add *Rondeau's* entire hair dye composition to *de la Mettrie's* hair dye composition. This addition would be unnecessary according to the Office's motivation. In other words, one would not need to add *Rondeau's* composition to that of *de la Mettrie* to achieve the desirous result, because *Rondeau's* compositions make it possible to achieve this result. Only hindsight by way of the present specification suggests this combination. Thus, the Office cannot meet its burden of establishing a *prima facie* case of obviousness for lack of the required motivation to combine and modify the teachings of *de la Mettrie* and *Rondeau*, and Applicants request that this rejection be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of the pending claims and the timely allowance of the pending claims.

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If any matters can be resolved by an interview over the telephone, please contact
Sean A. Passino at (202) 408-6065.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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